

**REMARKS/ARGUMENTS**

These Amendments to the Claims and Remarks are filed together with an RCE, following the Notice of Panel Decision from Pre-Appeal Brief Review, mailed on October 27, 2005, rejecting all pending claims after review of Applicants' Pre-Appeal Brief, filed July 21, 2005. Applicants believe that the Amendments present through continuing examination will result in allowance of the present application. The Amendments and Remarks respond to the Final Office Action mailed February 23, 2005 (the "Office Action").

Claims 1-27, 33-35, 47 and 48 were pending in the Application prior to the Office Action. In the Office Action, the Examiner rejected all pending claims. Currently, claims 4, 11-14 are cancelled. Claims 1-3, 5-10, 15-27, 33-35, 47, and 48 are pending in the application.

**I. Summary of Office Action**

Claims 1-3, 5-10 and 15-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ohkado (U.S. Patent No. 6,542,165; "Ohkado"). Claims 22-25, 27, and 48 were rejected for similar reasons without further analysis.

Claims 4 and 11-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ohkado in view of England (U.S. Patent No. 6,144,991; "England").

Claims 26 and 33-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ohkado in view of Gutfreund et al. (U.S. Patent No. 6,192,394; "Gutfreund").

Claims 21 and 47 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ohkado in view of Varma et al. (U.S. Patent No. 6,564,246; "Varma").

**II. Response to Rejections**

The present invention discloses a system whereby users are able to engage in conversations anchored to locations within commonly viewed files. These files are viewed from their native applications on the system of each user. The claimed system is especially efficient as it utilizes the file viewing capacities of applications associated with the file. For example, a Microsoft Excel document could be viewed from the Microsoft Excel application on the user's system. *Moreover, the past conversations are preserved in a persistent manner, providing a history of the conversation and information associated with the conversation.*

A. Rejection Pursuant to Section 103(a)

**SUMMARY of AMENDMENTS:** The Examiner rejected claims 1-3, 5-10, 15-20, 22-25, 27, and 48 over Ohkado, U.S. Patent No. 6,542,165 ("Ohkado"). Applicant respectfully disagrees because, as established below, independent claim 1, as well as independent claims 33, 47, and 48, all as currently amended, include limitations from several dependent claims (*i.e.*, claims 4, 11-14) that the Examiner has admitted are not disclosed in Ohkado. Moreover, as set forth in the following remarks, these limitations make the claims patentable over *all* of the cited art. Therefore, adding such limitations to the independent claims renders all of the independent claims patentable, and accordingly, all dependent claims also are patentable. Because the subject matter of certain dependent claims has been added to the independent claims, the dependent claims from which the limitations are derived have been cancelled (*i.e.*, claims 4, 11-14).

**EXPLANATORY REMARKS:**

The remarks that follow establish that independent claims 1, 33, 47, and 48 as amended, to comprise at least the limitations found in claims 13 and 14, are patentable over the cited art.

Applicant notes that the Examiner has admitted that the claims rejected over Ohkado do not recite the limitations found in dependent claims 4, 11-14, since the Examiner has not rejected claims 4 and 11-14 over Ohkado. Exemplary claims 13 and 14 are as follows:

13. The system according to claim 1, further comprising:  
a database mechanism configured to store conversation information of the conversation client in a database.

14. The system according to claim 13, wherein said conversation information includes a history of at least one of a location in the artifact of an anchor corresponding to the conversation client, and communications between the conversation client and another client.

Therefore, assuming that claims 13 and 14 are allowable over other cited art (which they are, as discussed below), the addition to independent claims 1, 33, 47, and 48 of the subject matter of dependent claims 13 and 14, *or narrower limitations supported in the specification*, will render allowable independent claims 1, 33, 47, and 48 as amended, and each of their dependent claims, over Ohkado and the other cited art.

Claim 1 as amended now reads:

1. (Currently amended) A system for placing and maintaining anchored conversations within an artifact comprising a file having a file type, the system comprising:

an application configured to access the artifact, wherein the application is associated with the file type;

a conversation client configured to access said anchored conversation and to receive communications regarding a portion of the artifact, while the artifact is viewed within the application;

an anchor configured to identify a location within said artifact with which said conversation client is associated; [[and]]

a conversation coordinator configured to maintain a relationship between the anchor, the conversation client and the anchored conversation;

at least one conversation database accessible by the conversation coordinator, said conversation database including a conversation history and access control data, wherein said conversation history comprises:

conversation elements and metadata, including command invocations, anchor positions, anchor context, conversation state changes, and shared artifact version data; and

wherein said access control data comprises access control lists, user accounts, and user privileges.

Comparable or identical limitations based on the subject matter of claims 13 and 14 also have been added to independent claims 33, 47, and 48.

The Examiner rejected dependent claims 4 and 11-14 over Ohkada in view of England (U.S. Pat. No. 6,144,991) ("England"). In the Office Action at page 7, *the Examiner admitted that Ohkada does not teach the limitations of claims 4 and 11-14:*

Ohkada fails to teach the limitation of a database configured to store conversations engaged in by said conversation client; wherein said conversation coordinator is further configured to allow a user access to any current or previous conversations stored in said database, a conversation retrieval mechanism configured to retrieve previous communications from the database that are associated with the requesting conversation client and load the retrieved previous communications into at least the recipient conversation client system.

The Examiner then argued:

However, England teaches a system for managing interactions between users in a network teaches of passively recording *a session conversation* (see col. 14; col. 20, England discloses that a session can be recorded by the director applications to a file and played back later through a user request).

Office Action at 7 (emphasis added). Applicant respectfully disagrees with the Examiner's rejection of claims 4 and 11-14 based on Ohkado in view of the England reference, and the arguments presented. As a preliminary matter, claims 4, 11-14 each have been cancelled because their subject matter now is incorporated into independent claims 1, 33, 47, and 48. However, the substantive rejection of those claims is remarked upon because the subject matter persists in the above-referenced independent claims. With regard to claims 13 and 14, the cited text in England (Cols. 14 and 20) does not disclose the limitations found those claims. In particular, Col. 14 merely refers to recording an interactive session, simply to be played back. England, Col. 14, lines 28-35. The cited Col. 20 merely discloses a "recording control frame 1002 [shown in Fig. 10] . . . which enables the guide to record a presentation in real-time. The recording can be paused if desirable." England, Col. 20, lines 43-45. In contrast, the disclosure of the present invention, and the limitations of claims 13 and 14 (and of independent claim 1 as amended) are distinct, at least because they go beyond mere recording and play-back. Claim 13 refers to "storing" "conversation information," not recording mere conversations, while claim 14 provides further limitations. Claim 14 specifies that "conversation information" comprises "a history of at least one of a location in the artifact of an anchor corresponding to the conversation client, and communications between the conversation client and another client." In order to illustrate that England does not disclose storing "conversation information" as contemplated in claims 13 and 14 (and amended claims 1, 33, 47, and 48 as discussed below), Applicants invite the Examiner to consider that England does not disclose, for example, recording and play-back of "a history of . . . a location in the artifact of an anchor . . ." or "a history of . . . communications between the conversation client and another client" as claimed in the independent claims 1, 33, 47, and 48 as amended of the instant application. England therefore does not supply the limitation of claims 13 and 14 that the Examiner admits Ohkado does not teach. Accordingly, claims 13 and 14 are allowable over the cited art.

Turning now to independent claim 1 as amended, Applicants submit that claim 1 (and independent claims 33, 47, and 48 as amended) also is allowable because of amendments that are drawn more narrowly than the limitations recited in claims 13 and 14 discussed above. Specifically, claim 1 as amended now teaches that the claimed system further comprises "at least one conversation database accessible by the conversation coordinator" the database including "conversation history and access control data." The claim language further specifies what "conversation history and access control data" comprise. Support for these limitations can be found in the specification, for example, at pages 17, 26, 27, 37, 42-44, 46, 50-58, and others. These limitations are not disclosed by England or Ohkada. Moreover, none of the other art cited against the present application discloses these limitations.

Accordingly, claim 1 as amended, as well as claims 13 and 14, are distinguished over the cited art. Because claims 2-27 (except the currently cancelled claims 4, 11-14) all depend, either directly or indirectly, from independent claim 1 as amended, these claims also are allowable over the cited art.

As noted, independent claims 33, 47, and 48 as amended also contain the limitations discussed above, and none of the cited art discloses these limitations. Accordingly, these independent claims also are allowable over the cited art which, as established above, does not contain the limitations discussed above.

Accordingly, all pending claims (*i.e.*, claims 1-27, 33-35, 47 and 48), as amended, are believed patentable over the cited references and reconsideration of the rejections is respectfully requested.

CONCLUSION

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if she can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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By: 

Melissa L. Basch  
Reg. No. 56,159

FLIESLER MEYER LLP  
Four Embarcadero Center, Fourth Floor  
San Francisco, California 94111-4156  
Telephone: (415) 362-3800  
Fax: (415) 362-2928  
Customer No. 23910

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